

REMARKS

The Examiner has made three rejections of the claims based on 35 U.S.C. §112, second paragraph. First, the Examiner rejects Claims 1, 10, 19, and 22 for the term "long-wearing" because the term is not defined by the claim, and the specification does not provide a standard for ascertaining the requisite degree of "long-wearing." However, at page 5, lines 29 to 31, it is disclosed in the present specification that the compositions used to create an art form on the skin can be retained for up to a full day without smudging or running. Further, at page 1, lines 5 to 6, the long-wearing cosmetics are described specifically as cosmetics that do not smear, run or settle in the lines and creases of the skin. Thus, one of ordinary skill in the art can ascertain the requisite degree of measurement to understand the metes and bounds of the term "long-wearing" as used in the claims of the present invention.. "If claims when read in the light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, requirements of §112, second paragraph are satisfied." *North American Vaccine Inc. v. American Cyanamid Co.*, 28 USPQ2d 1333, 1339 (CAFC 1993)(citing *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F. 2d 613, 624, 225 USPQ 634, 641 (Fed. Cir.), *cert. dismiss.*, 474 U.S. 976 (1985)).

Next, the Examiner rejects Claims 1 to 4, 6 to 13, and 15 to 21. Specifically, the Examiner finds that the word "derived" is unclear and that the specification does not provide an exclusive definition of the derived polymers and copolymers, and therefore, that the metes and bounds of the claims cannot be determined. However, §112, second paragraph does not require an exclusive definition, rather the claims when read in light of the specification must reasonably convey to one skilled in the art the scope of the invention using language as precise as permitted by the subject matter. In the present specification, at page 3, lines 19 to 30, the polymeric component of the present invention is described. Specifically, the polymeric or copolymeric component includes homopolymers and copolymers of acrylic acid, methacrylic acid, and esters of acrylic or methacrylic acid. Therefore, one of ordinary skill in the art would understand the scope of the acrylic acid derived polymer and copolymer recited in the claims in light of the specification.

Finally, Claims 3, 12, and 20 are rejected by the Examiner as being indefinite because they claim a polymeric component having an indefinite number of carbon atoms because its description is preceded by the word "about". The Examiner suggests that deletion of the word "about" would overcome this rejection. Applications have made the amendment as suggested by the Examiner, and therefore, request that this and the other rejections based on §112, second paragraph be withdrawn.

The Examiner has rejected the invention under 35 U.S.C. §102 in view of Calvo et al., U.S. Patent No. 5,324,506 ("the '506 reference") because the Examiner incorrectly finds that it discloses the water soluble organic pigments of the present invention. The present invention relates to long-wearing compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component and at

least one water-soluble organic pigment. The composition is water resistant and does not run or settle into lines and creases on the skin. Although the '506 reference discloses water-soluble dyes, it does not disclose the addition of its solvated dye, *per se*, to a non-clogging liquid composition containing the polymer of the present invention. Rather, the solvated dye of the '506 reference is converted to an insoluble pigment. The solvated dye is merely the starting material and is not part of the finished product as a solvated dye.

As disclosed in the abstract, the '506 reference discloses how to make an insoluble pigment by incorporating a solvated dye into a resin. The pigment is defined by the '506 reference, at column 1, lines 41 to 43, as any soluble dye converted to an insoluble form. Specifically, at column 3, lines 11 to 19, and at column 4, lines 9 to 24, it is disclosed that the solvated dye is incorporated into the resin (capable of being pulverized to a fine **powder**) to form an insoluble pigment. It is the insoluble pigment that is added to a cosmetic carrier, not the solvated dye. According to the '506 reference, the combination of solvated dye and molten resin is dried to a powder and can be further pulverized to make a fine powder. Pigments are inherently by definition particulate, and therefore, the '506 reference which discloses how to convert a solvated dye into an insoluble pigment, fails to disclose the present invention of a water soluble organic pigment in a cosmetic composition. The water soluble organic pigment is simply combined with the polymeric component of the present invention to form a flowable cosmetic for use in a flow-through cosmetic applicator, as disclosed at page 5, lines 12 to 19. The disclosure in the '506 reference of the solvated dye incorporated in the resin is to form an insoluble pigment that is quite unlike the flowable arrangement of the water soluble organic pigment and the acrylic derived polymeric component of the present invention. As the '506 reference fails to disclose the present invention of a combination of a water soluble organic pigment and the polymeric component, Applicants request that the present anticipation rejection be withdrawn.

The Examiner rejects Claims 1 to 14, and 19 to 22 under 35 U.S.C. §103, over the '506 reference in combination with U.S. Patent No. 4,988,502, issued to Ounanian ("the '502 reference"). As disclosed in the '506 reference, at column 1, lines 35 to 36, to be useful as cosmetic colorants, soluble dyes must be converted into insoluble forms. Therefore, the '506 reference teaches the conversion of a solvated dye to an insoluble pigment, and thus, this reference, alone or in combination with the '502 reference, fails to render the present invention obvious. Further, the '506 reference teaches away from the present invention. As the court has recently noted, it is a "useful general rule," that references that teach away cannot serve to create a *prima facie* case of obviousness. *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1010 (CAFC 2001)(citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994)).

The Examiner asserts that the present invention is obvious because one of ordinary skill in the art would reasonably expect to obtain a non-sticky cosmetic composition by adding the ammonium acrylate copolymer of the '502 reference to the '506 compositions. However, this line of reasoning is incorrect since

neither the '506 reference nor the '502 reference teaches a water soluble organic pigment. As presented above, the '506 reference fails to teach or suggest a water soluble organic pigment added directly to a cosmetic composition without incorporating it in a resin to render it an insoluble pigment in the cosmetic carrier. This is unlike the present invention which adds the water soluble organic pigment directly to the cosmetic composition containing an acrylic based polymeric component. The resulting cosmetic is flowable and is not the insoluble pigment of the '506 reference. Thus, the teachings of the '506 reference do not make the present invention. Further, the addition of the acrylate copolymer taught in the '502 reference to the '506 pigment will still not make the present invention because this does not alter the insoluble '506 pigment. The present invention is the combination of a water soluble organic pigment with an acrylic based polymeric component to make a flowable cosmetic that does not run and does not clog flow-through cosmetic applicators. This is not taught or suggested by the cited references, alone or in combination.

Finally, the Examiner rejects Claims 1 to 4, 6 to 13, and 15 to 21 under 35 U.S.C. §103, as being unpatentable over the '506 reference in combination with U.S. Patent No. 4,761,277 ("the '277 reference") because the '277 teaches that flow-through eyeliner pens having a nib are conventional in the art. As previously discussed, the '506 reference fails to teach water soluble organic pigments added directly to a cosmetic composition containing an acrylic based polymeric component. The '506 reference, contrary to the present invention, discloses the addition of an insoluble pigment to a cosmetic composition, where the insoluble pigment is made by its incorporation within the resin. This is not the present invention, and the combination of the '506 reference with the '277 reference does not teach or suggest the present invention.

Finally, the '506 reference teaches away from the present invention because it teaches, at column 1, lines 35 to 36, that a soluble colorant must be converted to an insoluble form to be basically useful in a cosmetic composition. This is precisely the opposite of the present invention which is a beneficial combination of a water soluble organic pigment with an acrylic based polymeric component. The base of the present invention is predominantly aqueous and is in the form of a flowable cosmetic such as an eyeliner or body paint for use in a flow-through applicator. The surprising element of the present invention is that, although it is primarily aqueous, it does not run when applied to the skin. Furthermore, the cosmetic of the present invention does not clog the wick of nib-type pens even though it contains an acrylic based polymeric component. These surprising benefits are not recognized by the cited prior art, and therefore, the claims of the present invention are not obvious and are patentable. A *prima facie* case of obviousness can be rebutted by showing "unexpected results," *i.e.*, to show that the claimed invention exhibits a superior property or advantage that a one of ordinary skill in the art would have found surprising or unexpected because that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious. *In re Soni*, 34 USPQ2d 1684, 1687 (CAFC 1995). Therefore, Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a).

Finally, the Examiner requested clarification of FD&C green no. 5 in claim 8 as the Examiner did not find a definition or listing of "FD&C green no. 5". Applicants submit herewith a copy of 21 CFR 74.2205 for D&C Green No. 5, and amend claim 8 to clarify that the particular water soluble organic pigment is "D&C green No. 5".

In view of the arguments presented above in the present submission, the claims of the present invention are believed to be in condition for allowance because they are definite and because the present invention described in the claims in view of the cited references is novel and non-obvious. Accordingly, Applicants request that the Examiner's rejections be withdrawn and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

12/17/01



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MARKED AMENDMENTS

3 (Amended). The composition of claim 2 wherein said polymeric component comprises monomeric elements having [about] 1 to 18 carbon atoms.

8 (Amended). The composition of claim 7 wherein said water soluble organic pigment is selected from the group consisting of FD&C blue No.1, [FD&C] D&C green No. 5, FD&C red No. 40, FD&C yellow No. 5, and combinations thereof.

12 (Amended). The composition of claim 11 wherein said polymeric component comprises monomeric elements having [about] 1 to 18 carbon atoms.

20 (Amended). A method according to claim 19 wherein the polymer comprises monomeric elements having [about] 1 to 18 carbon atoms.